REMARKS

Claims 1-23 are pending in the instant application. Of these, claims 12-23 were previously withdrawn due to a Restriction Requirement. Claims 1-11 have been rejected by the Examiner. The Applicants traverse the outstanding rejections and submit that claims 1-11 are in condition for allowance. Reconsideration and allowance of the application in view of the following remarks are respectfully requested.

Rejections Under 35 U.S.C. §102

Claim 1 is rejected under 35 U.S.C. §102(e) as being allegedly anticipated by Abbott et al. (US 2004/0236641)(hereinafter "Abbott").

With respect to claim 1, the Examiner states that Abbott discloses "identifying at least one excess component inventory liability or at least one constraint in supply capability for an end product by matching current buying patterns for said end product against inventory liability and supply capability based on a previous demand forecast," citing by way of example, page 1, paragraph [0005] and page 4, paragraph [0052] in support. The Applicants respectfully disagree. Abbott discloses a method for processing end of lease computer equipment by equipment manufacturers (page 1, para. [0002]). The decision made in Abbott is concerned with which is more profitable, selling the equipment on the used market, or dismantling it and repurposing the used parts in other equipment (Id.). The process does not disclose excess or constraint in the supply capability and, as described previously, where there is no constraint in supply, or in the case where there is excess supply of parts, Abbott would operate by simply selling the entire machine on the used market. Additionally, page 4, paragraph [0052] of Abbott discloses a method for "generating forecasted demand data for parts" and storing those results for later use in determining the optimal dismantling configuration. The Applicants' claimed invention uses a previously generated demand forecast as a comparison to current buying patterns to determine whether or not there will be supply excess or shortage rather than generating a demand forecast. The differences between Abbott and the Applicants' claimed invention are more than simply the timing of the demand forecast, however. Abbott looks at current orders to make decisions, while the Applicants look at prior trends to "forecast" demand and then take appropriate action. Abbott does not teach or suggest either "bas[ing decisions] on a previous demand," nor does Abbott teach or suggest "forecasting." Therefore, Abbott fails to teach or suggest, "matching

current buying patterns for said end product against inventory liability and supply capability based on a previous demand forecast."

The Examiner further alleges that "offers to terminate their leases early to obtain leased equipment for meeting the not-covered parts demand" disclosed in Abbott is equivalent to "[e]stablish[ing] incentives for buying or selling." Abbott's offer to terminate the lease, however, is not designed as an incentive to buy or sell but is instead used to generate more parts for the "not-covered parts list represent[ing] parts demand that is not covered by the machine supply" (page 5, para. [0070]). In addition, terminating a lease is not the same as buying or selling a piece of equipment. One of ordinary skill in the art would appreciate that a lease of equipment does not create an ownership right and that termination of the lease is not a sale or purchase. Therefore, both Abbott's motive—to acquire equipment in order to dismantle it for parts—and its method—incenting customers to terminate their leases—are different than that of the Applicants, which is inducing sales by offering incentives.

In addition, the Examiner alleges that "virtual supply embodiment can be used to support advanced advertising of a forecasted parts supply that the system predetermines would produce the most profit" (page 7, para [0097]) teaches "[d]evelop[ing] a promotion for long-term overages through advertisements." Abbott uses advertising to maximize profit. This is different than "executing sales activities operable for enticing sales of said alternative end products." One distinction being that Abbott's virtual supply embodiment "converts machine supply to a virtual part supply" (page 7, para. [0096]). This is in contrast to the Applicants' recited "enticing sales of said alternative end products." Abbott does not teach "enticing sales of said ***alternative*** end products," and it is not inherent in the sales activities described in Abbott. The sale of component parts is not the same as "alternative products" in the Applicants' invention.

The Examiner also alleges that Abbott teaches "determining alternative end products" (Office Action, page 13 para. 2). Abbott, however, is devoid of teaching alternative end products and teaches only optimal dismantling options for parts generation ("to determine how to dismantle a machine supply to collect specific parts for meeting a parts demand at a lowest cost," para. [0006], "In accordance with the present invention, various dismantling configurations are considered to meet the parts demand at the lowest cost," para. [0017], Figs. 2, 4, and 5). Abbott, therefore, is entirely devoid of teaching this feature, and is particularly devoid of linking the demand and supply activities to "executing sales activities," as recited in claim 1.

Also, with respect to Applicants' claim 1, Abbott fails to teach or suggest, "where constrained supply capability exists: determining alternative end products that are functionally equivalent to those identified in said at least one constrained supply capability; and executing sales activities operable for enticing sales of functionally equivalent alternative end products." The Examiner points to page 5, paragraph [0069] in support of the rejection. However, this portion of Abbott defines a way of separating excess part demand in two alternate groupings: the first being parts whose demands can be met by dismantling existing machines, the second a list of parts whose demand cannot be by dismantling machines. The solution to the shortage of the parts taught in Abbott is to seek another source of the parts to fill the demand. By contrast, Applicants' claimed invention defines a process of seeking out alternate products when demand for a requested product cannot be filled. In this manner, a customer's demand may be satisfied without the need to seek alternate sourcing.

The Examiner further alleges that Abbott teaches "determining alternative end products that are functionally equivalent to those identified in said at least one constrained supply capability; and executing sales activities operable for enticing sales of functionally equivalent alternative end products." The Examiner compares reconstruction of parts into new machines to "determining alternative end products that are functionally equivalent to those identified in said at least one constrained supply capability." The comparison is not, however, justified. The Applicants' alternative product determination is to ease "constrained supply capability" where Abbott's process determines a best use for excess spare parts. Therefore, the parts in Abbott are not used to make "functionally equivalent" machines but rather to make the exact machines that the customers require. The very problem that the Applicants' invention tries to solve, "constrained supply capability," does not exist in Abbott, which tries instead to fill the orders using existing part supplies.

Additionally, with respect to Applicants' claim 1, Abbott fails to teach or suggest, "wherein said sales activities result in reducing said at least one excess component inventory liability or avoiding said at least one constraint in supply capability." The Examiner relies upon page 1 paragraph [0006] in support of the rejection. As disclosed in Abbott, the object is to create a cost effective means of disposing of excess machine equipment by determining an optimal machine dismantling process to fill any excess demand for parts. By contrast, the

activity recited in this portion of Applicants' claim 1 seeks to avoid excess demand for, or excess supply of, products through various means, as supported in the claims.

As Abbott does not teach or suggest each and every element recited in Applicants' claim 1, the Applicants submit that claim 1 is not anticipated by Abbott and, for at least the reasons stated above, is in condition for allowance. Reconsideration and withdrawal of the outstanding rejection is respectfully requested.

Rejections Under 35 U.S.C. §103(a)

Claims 3-10 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Abbott et al. (US2004/0236641) (herein after "Abbott"). Claims 2 and 11 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Abbott et al. (US 2004/0236641) as applied to claim 1 above under USC 102(e), in view of Kennedy et al. (US 6,167,380) (hereinafter "Kennedy"). The rejections of claims 2-11 are respectfully traversed for at least the reasons presented herein.

For applications filed on or after November 29, 1999, this type of rejection may be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See 35 U.S.C. 103 (c), MPEP 706.02(l)(1) and 706.02(l)(2). As noted below, Application serial number 10/660,850 and Application serial number 09/808,067 were, at the time the invention of Application serial number 10/660,850, subject to an obligation of assignment to International Business Machines Corporation. Therefore, Abbott et al. (US 2004/0236641) is disqualified as prior art and may not be used in a 35 U.S.C. 103(a) obviousness rejection. Accordingly, the various rejections of claims 3–10 under 35 U.S.C. § 103(a) should be withdrawn.

Claims 2 and 11 are rejected under Abbott in view of Kennedy. As indicated above, Abbott is disqualified as a reference under 35 U.S.C. §103(c) and may not be used in conjunction with Kennedy to reject claims 2 and 11. Moreover, Kennedy does not cure the aforementioned deficiencies outlined above. For at least this reason, the Applicants submit that claims 2 and 11 are in condition for allowance.

Conclusion

In view of the foregoing remarks, it is submitted that the application is in condition for allowance. Such action is therefore respectfully requested.

If a communication with Applicants' Attorneys would assist in advancing this case to allowance, the Examiner is cordially invited to contact the undersigned so that any such issues may be promptly resolved.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 50-0510. In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

CANTOR COLBURN LLP
Applicant's Attorneys

By: /Marisa J. Dubuc/
Marisa J. Dubuc
Registration No. 46,673
Customer No. 48915

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Address: 20 Church Street, 22nd Floor
Hartford, CT 06103-3207
Telephone: (860) 286-2929
Fax: (860) 286-0115